

## REMARKS/ARGUMENTS

### **35 U.S.C. 102 Rejection (Shaw)**

The Office rejected Claims 25, 26, 28, 30 and 32 under 35 U.S.C. 102(b) as being anticipated by Shaw (US 5261818). Applicant respectfully traverses those rejections.

Rejected Claim 25 required the step of "providing a shaft having (a) a proximal end with a first opening, (b) a distal end with a second opening and a beveled cutting surface." Shaw fails to teach use or existence of such a device. Shaw teaches a drill bit 10 having an irrigation channel (18), but as previously admitted by the Examiner, that channel does not extend all the way to the end of the cutting tip 14. See Shaw figures 1, 2, and 6.

Rather than argue the technicalities of the term "end", the Applicant in this office action has clarified that the second opening extends through the beveled cutting tip. Shaw fails to satisfy that limitation by any reasonable definition of the term "tip". Shaw's openings 24 are all proximal to the cutting tip. A further clarification is made that the medicament is injected through the shaft, to exit through the second opening.

Claims 26, 28, 30 and 32, of course, all have the same limitations by virtue of their dependency on Claim 15.

### **35 U.S.C. 103 Rejections (Shaw)**

The Office rejected Claims 27 and 31 as being obvious over Shaw (US 5261818). Applicant respectfully traverses those rejections.

Claim 27 recites that the "overall length" is about 0.10 to 0.125 inches. Just to clarify, the overall length as used in the claims is defined in Claim 25 as extending "from a distal tip of the cutting tip to a proximal end of the open notch." The "overall length" is not, as apparently construed by the Office, the "length of the drill." Shaw doesn't even have an open notch, so it is difficult to see how this claim could be obvious over Shaw.

Claim 31 is dependent on Claim 30, which was not deemed to be obvious. It is logically impossible for Claim 31 to be obvious when it is dependent on a Claim that is non-obvious.

### **Claim 16**

There is no need to discuss Claim 16 because that Claim has been canceled.

### **35 U.S.C. 103 Rejections (Shaw in view of Pshenichny)**

The Office rejected Claims 29, 33 and 34 as being obvious over Shaw (US 5261818) and Pshenichny (US 3750667). Applicant respectfully traverses those rejections.

Claim 29 recites that the shaft is smooth. This Claim is allowable, at least by virtue of its dependency on Claim 25.

Claims 33 and 34 focus on the hub. These Claims are allowable by virtue of their dependencies on Claim 25, and also by virtue of amendments herein that recites the shaft extending outward beyond the hub, and that the lumen extends beyond both proximal and distal ends of the hub, respectively. Pshenichny doesn't have a hub through which a lumen extends on both ends. Element 12 is a depth restrictor, not a hub.

### **Reliance On Decision On Appeal**

The Office is taking that position that with respect to the "overall length" claims, the Applicant is trying to reargue points already decided on appeal. That is not the case. The Appeals board focused on: (1) whether Shaw's lumen connected the first and second openings; (2) whether Shaw's lumen receives debris from the first opening as a result of cutting; (3) whether a "channel" is the same as a "lumen"; and (4) whether the "overall length" is patentably distinguishing *per se*. Those arguments are not being relied upon in any manner in asserting patentability of the present claims.

### **Request For Allowance**

Claims 25-34 are pending in this application. The Applicant requests allowance of all pending claims.

Respectfully submitted,  
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